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Docket No.: A7542.0000/P001-D
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dr. Ginette Serrero

Application No.: 09/880,842 Group Art Unit: 1642

Filed: June 15, 2001 Examiner: N. Davis

For: METHODS AND KITS FOR DIAGNOSING TUMORIGENICITY AND DETERMINING RESISTANCE TO THE ANTINEOPLASTIC EFFECTS OF ANTIESTROGEN THERAPY

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed January 23, 2002 (Paper No. 6), Applicant hereby provisionally elects claims 1-65 and species A (immunological assay) for continued examination, with traverse.

The Examiner has required restriction between:

Group I, claims 1-65, drawn to methods of diagnosing tumorigenecity, determining antineoplastic effects of anitestrogen therapy, and determining resistance to antineoplastic effects;

Group II, claims 66-81, drawn to a kit for determining tumorigenecity in breast tissue; and

Group III, claims 82-85, drawn to a method of treating or preventing the re-occurrence of cancer.

In addition, if Group I or Group II is elected, the Examiner is requiring the election of one of the following species: species A (immunological assay) or species B (cDNA probe).

Given the closely related subject matter of the various groups, Applicant respectfully submits that restriction of the pending claims is unreasonable. The search for the claims of Group I would overlap the search for claims of each of the other groups and no undue burden would be involved in examining these claims together. This is particularly so with regard to Group I and II. According to the restriction requirement, the Group I claims can be practiced with a product other than the kits of the Group II claims. For example, according to the restriction requirement, the methods of the Group I claims can be practiced by using a product for determining the expression of BRAC1. However, the methods of the Group I claims cannot be carried out using a product for detecting an unrelated molecule such as BRAC1. We strongly encourage the Examiner to at least amend the requirement and combine Groups I and II for the reasons set forth above.

M.P.E.P. § 803 directs as follows (emphasis added): "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." The Examiner should follow this directive in this case and the restriction requirement should be withdrawn.

Dated: February 22, 2002

Respectfully submitted,

By _____

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